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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/977,243	10/16/2001	Peter F. Reile	FSHR-042/00US 063518-2286	2235
27896 7590 11/30/2009 EDELL, SHAPIRO & FINNAN, LLC 1901 RESEARCH BOULEVARD SUITE 400 ROCKVILLE, MD 20850			EXAMINER DEODHAR, OMKAR A	
			ART UNIT 3714	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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epatent@usiplaw.com

<b>Office Action Summary</b>	<b>Application No.</b> 09/977,243	<b>Applicant(s)</b> REILE ET AL.	
	<b>Examiner</b> OMKAR A. DEODHAR	<b>Art Unit</b> 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9, 19, 21-26, 28, 31-41, 43-52, 54, 55 and 57-65 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 19, 21-26, 28, 31-41, 43-52, 54-55, 57-65 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### **Non-Final Rejection**

#### ***Response to Arguments & Amendment***

Applicant's arguments regarding prior art have been considered but are moot in view of the new ground(s) of rejection. Applicant's arguments regarding Section 112 rejections are persuasive.

The claims recite instances of functional language; requiring only prior art ability to perform. (See Claim 26, "capable of", or Claims 33-40, "configured to"). Applicant is encouraged to positively recite claim limitations.

#### ***Claim Rejections - 35 USC § 112***

Claim 22 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 22 recites "after the determining the first characteristic." Examiner believes this should recite "after determining the first characteristic." Correction/Clarification is requested.

#### ***Claim Objections***

Claim 21 is objected to because it recites "a first indicia" & "a second indicia". The singular form of indicia is "indicium". Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-9, 19, 21-26, 28, 31, 32, 52, 54, 55 & 57-65 are rejected under 35**

**U.S.C. 102(b) as being anticipated by Lynch (US 5,896,133).**

**Claim 1:** Lynch discloses a hand-held electronic toy (A device; See Fig. 1, Col. 4. Lines 49-56 disclosing a handheld personal computer. See Fig. 4B, 245 showing access to games), comprising: a touch-screen display (See Col. 4. Lines 60-65 disclosing a touch screen);

and a toolbar disposed on said touch-screen display (See Fig. 3, 182 showing a toolbar), said toolbar including a plurality of interactive tools (Id. A plurality of tools are shown), a first interactive tool from the plurality of interactive tools enabling the selection of one of a plurality of drawing activities displayed on the touch-screen display in response to one of said plurality of drawing activities displayed on the touch- screen display being touched (See Fig. 3. tool holder button 198 provides access to drawing tools. See also Col. 7. Lines 43-45).

a second interactive tool from the plurality of interactive tools enabling the selection of one of a plurality of characteristics associated with said second interactive tool from the plurality of interactive tools (Fig. 3. notebook 160 is a second interactive tool. When selected, the screen shown in Figure 9A provides access to control portion 434 {another toolbar}. The control portion is interpreted as providing a plurality of characteristics.),

said second interactive tool being activated upon the selection of said one of said plurality of drawing activities (selecting the notebook 160 is interpreted as selecting one

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of said plurality of drawing activities. Such selection activates a screen as shown in Fig. 9A),

and said second interactive tool being inactivated upon the selection of another activity differing from said one of said plurality of drawing activities and said plurality of characteristics associated with said second interactive tool configured to vary based on the selection of said one of said plurality of drawing activities. (When a user selects any of the numerous other tools provided on the handheld device, the second interactive tool {the notebook} is inactivated. Characteristics associated with the second interactive tool {such as the "Discard" button 438 in Fig. 9A} are available for other tools such as the screen shown in Fig. 8. {the "Discard" button 427}. Additionally, note that the second interactive tool's characteristics may be unique to said tool, as in the "New" button 437 in Fig. 9A.)

**Claim 2:** Lynch discloses a memory for storing code associated with the drawing activities. (See Fig. 1, memory 104 for storing code).

**Claims 3, 5, 25:** See Col. 4. Lines 53-56 disclosing read only memory including removable magnetic discs. Inserting a disc is interpreted as inserting a cartridge having read only memory. Program or activity data is encoded onto the disc. The disc is inserted into a port configured to accept the disc. As set forth above, a plurality of interactive tools enable selection of activities. In the magnetic disc embodiment, these tools would be loaded from the disc.

**Claim 4:** See Fig. 1, optional card slot 109, disclosing a communication device configured to receive data from a second source. See also Fig. 1. communication device 108.

**Claim 6:** See Fig. 26 showing an online news service. This discloses a communication device receiving data from a second source; the internet.

**Claim 7:** See Fig. 12 showing electronic mail. This means that the communication device receives data from other online devices including a second communication device.

**Claims 8, 9:** See Fig. 1, stylus 110, allowing the user to select any of the activities shown in Fig. 3. The stylus is an input device allowing the user to interact with the touch-screen display.

**Claim 19:** Lynch discloses a method comprising receiving a selection of one activity from a plurality of activities for display on a display of a hand-held electronic toy, the plurality of activities including at least one drawing activity; (See Fig. 3. tool holder button 198 provides access to drawing tools. See also Col. 7. Lines 43-45. A user selects the tools via the touch screen display or stylus {Fig. 1, 110}).

receiving a selection of an interactive tool, the interactive tool being associated with a selectable icon in a toolbar (See Fig. 3, tool holder 198 is a selectable icon), the selected interactive tool including at least one selectable characteristic (tool holder 198 is selectable and thus interpreted as having a selectable characteristic), the selected interactive tool being activated upon the selection of the at least one drawing activity, (when the tool holder 198 is selected, the drawing tool is activated) and the selected

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interactive tool being inactivated upon the selection of another activity from the plurality of activities differing from the at least one drawing activity (See Fig. 3, Toolbar 182 has a plurality of activities. When another activity is selected (such as the keyboard 199, the drawing activity is inactivated & the keyboard function is activated)

determining if the selected interactive tool is activated (when selected, the tool is activated) and if the selected interactive tool is activated, displaying indicia of the at least one characteristic associated with the selected interactive tool (the user is presented with characteristics associated with drawing activities), the at least one selectable characteristic of the selected interactive tool including a drawing characteristic unique to the selected one of a plurality of activities (drawing functions, or characteristics are unique to the tool holder feature.)

**Claim 21:** Lynch discloses the plurality of activities including a first activity and a second activity, the first activity being a drawing activity (See Fig. 3, drawing tool holder button 198), the displaying indicia further comprising: displaying a first indicia associated with the drawing activity (tool holder 198); and displaying a second indicia associated with the second activity (keyboard 199), the first indicia being different than the second indicia. (the icons for tool holder 198 & keyboard 199 differ; as do the rest of the icons on toolbar 182).

**Claims 22, 23, 63:** Lynch discloses a method, comprising: retrieving a first activity application from a memory for display on a hand-held electronic toy (See Fig. 3, tool holder 198 is displayed. Fig. 1 discloses memory storing the various applications

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shown on toolbar 182 in Fig. 3) the first activity being a drawing activity application (Tool holder 198 provides access to writing & drawing tools. See also Col. 7. Lines 42-45);

determining a first characteristic of a selected interactive tool associated with an icon on a toolbar disposed on the hand-held electronic toy, the first characteristic being configured to interact with the retrieved drawing activity application (Col. 7. Lines 42-45 discloses that tool holder 198 provides access to a writing & drawing tools. One drawing tool is interpreted as one characteristic that interacts with the drawing application);

after determining the first characteristic, retrieving a second activity application from a removable read-only memory cartridge for display on the hand-held electronic toy (This is anticipated by a user choosing another drawing tool from the plurality of drawing tools disclosed at Col. 7. Lines 42-45. The activity application would be retrieved from the read only memory disclosed in Col. 4. Lines 53-56);

and determining a second characteristic of the selected interactive tool associated with the icon on the toolbar disposed on the hand-held electronic toy, (the second characteristic associated with the drawing tool holder is interpreted as the erase button 439 shown in Fig. 9A) the second characteristic being activated upon retrieving second activity application from the removable read only memory cartridge, and inactivated upon retrieving the first activity application. (The claimed activation & inactivation are disclosed at least with respect to a drawing activity using the pencil tool 198 {Fig. 9A} & the erase tool 439 {Fig. 9A}. For example, when the erase tool is activated, the pencil tool would be inactivated & vice, versa.)



**Claim 24:** Lynch discloses wherein said determining the first characteristic includes determining contents of a second menu of tool options that is associated with the interactive tool.(See Fig. 9B showing a plurality of starter scenes to draw on. {Graph paper, lined paper, etc.} It is shown in "menu" format. The plurality of starter scenes is a menu of tool options).

**Claims 26, 28, 65:** Lynch discloses a method in a hand-held electronic toy (Abstract, comprising: displaying a first selectable item on said hand-held electronic toy (Fig. 3. drawing tool holder 198), said first selectable item including a plurality of activities capable of being displayed on said hand-held electronic toy on a touch-screen display of said hand-held electronic toy, at least one of said plurality of activities being a drawing activity; (The prior art is "capable of" displaying the plurality of activities. This is mere functional language that requires only prior art ability to perform. One such scene is shown in Fig. 9A with regards to the notebook feature.)

displaying a plurality of selectable starter scenes on said touch-screen display of said hand-held electronic toy based on a selection of said one drawing activity from said plurality of drawing activities; (See Fig. 9B showing a plurality of starter scenes to draw on. {Graph paper, lined paper, etc.} It is shown in "menu" format).

upon receipt of a selection of a starter scene from said plurality of selectable starter scenes modifying at least one characteristic associated with an interactive tool on a toolbar from a first state to a second different state based on the selection of said starter scene (Fig. 9B, after selection of a starter scene, box 440 would disappear. It is interpreted as a characteristic associated with the tool. It is modified because it is no

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longer displayed), wherein said at least one characteristic is associated with said interactive tool being activated upon the selection of a drawing activity and inactivated upon the selection of another of said plurality of activities differing from said drawing activity; (The image shown in Fig. 9B is activated upon selection of a drawing activity such as the notebook tool & would be inactivated by selecting another activity on the toolbar, unrelated to a drawing activity) and displaying said at least one characteristic on said touch-screen display of the-said hand-held electronic toy. (Fig. 9B, box 440).

**Claim 31:** Lynch discloses features as presented above & additionally, that the port (Fig. 1. 109 or 111) is configured to receive a cartridge including a second removable read-only memory, the second removable read-only memory including code associated with a second drawing activity and having data associated with the at least one of a plurality of interactive tools, the second characteristic being configured for use and operable with the second drawing activity and inoperable with the first drawing activity.

(In Fig. 1, at least two memory ports are shown, (109 & 111). In Col. 4. Lines 53-56, Lynch discloses read only memory including removable magnetic discs for loading activity data. Applicant's claims recite functional language ("configured for") a particular use. The prior art's memory devices are capable of performing the claimed steps.)

**Claim 32:** Lynch discloses a hand-held electronic toy (Abstract), comprising: a touch-screen display (See Col. 4. Lines 60-65 disclosing a touch screen); and a toolbar on the touch-screen display, the toolbar having a fixed appearance (Fig. 9A, fixed toolbar 430), the toolbar including a plurality of selectable icons, (Icons such as 439 &

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440 are selectable), each of the plurality of selectable icons associated with at least one drawing tool, (The icons on toolbar 430 are associated with the notebook tool), each of the plurality of selectable icons being activated or inactivated based on a first an activity selected from a plurality of selectable activities (the tools are activated based on selection of the notebook tool) and inactivated based on a second activity selected from the plurality of selectable activities (the tools are inactivated if the notebook tool is not selected).

**Claim 52, 54, 55, 57, 62:** Lynch discloses wherein the toolbar is a printed toolbar. See Fig. 3, toolbar 182, printed on the bottom of the screen.

**Claims 58-61:** Lynch discloses a user modifiable display portion. (See Fig. 3A user can select any of the various tools & modify the default display to instead display the activity indicated by the tool. Additionally, see Fig. 9A showing an erase tool.)

**Claim 64:** Lynch discloses wherein the second activity is a gaming application. (See Fig. 22 showing a gameroom scene.)

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 33-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lynch (US 5,896,133) in view of Microsoft Paint © (copyright 1981-1998, version 4; previously cited.)**

**Claims 33-41:** Lynch discloses the invention substantially as claimed but does not disclose that the hand-held device & drawing tool have the following features:

wherein the at least one drawing tool includes a straight line tool, the straight line tool configured to allow a user to render lines on the touch-screen display using a drawing stylus at a user-selectable line thickness; wherein the hand-held electronic toy is configured to display a pop-up menu on the touch-screen display, the pop-up menu including a graphical representation of a plurality of line thicknesses to the user & a special effects tool; wherein the at least one drawing tool includes a primary shapes tool, the primary shapes tool associated with a plurality of secondary shapes tools, the primary shapes tool configured to allow a user to select one of the plurality of secondary shapes tools, each of the plurality of secondary shapes tools configured to allow a user to render a corresponding one of a plurality of predetermined shapes on the touch-screen display using a drawing stylus; wherein the hand-held electronic toy is configured to display a pop-up menu on the touch-screen display, the pop-up menu including a graphical representation of the plurality of secondary shapes tools to the user; wherein the plurality of secondary shapes tools include a square drawing tool, a polygon pool, a special effects tool to alter an image and a reverse out tool, rotate tool & a mirror tool.

Microsoft paint teaches wherein the at least one drawing tool includes a straight line tool, the straight line tool configured to allow a user to render lines on the touch-screen display using a drawing stylus at a user-selectable line thickness, wherein the hand-held electronic toy is configured to display a pop-up menu on the touch-screen display, the pop-up menu including a graphical representation of a plurality of line thicknesses to the user & a special effects tool; wherein the at least one drawing tool

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includes a primary shapes tool, the primary shapes tool associated with a plurality of secondary shapes tools, the primary shapes tool configured to allow a user to select one of the plurality of secondary shapes tools, each of the plurality of secondary shapes tools configured to allow a user to render a corresponding one of a plurality of predetermined shapes on the touch-screen display using a drawing stylus; wherein the hand-held electronic toy is configured to display a pop-up menu on the touch-screen display, the pop-up menu including a graphical representation of the plurality of secondary shapes tools to the user; wherein the plurality of secondary shapes tools include a square drawing tool, a polygon pool & a special effects tool to alter an image. (See Pages 11-13 of the Office action dated 7/6/2004, where Examiner provided screenshots of each of these features.)

As evinced by Microsoft Paint, the features of claims 33-40 were known prior to Applicant's invention. Indeed, any PC purchased with Microsoft Windows included this software. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to provide the tools taught by Microsoft Paint in Lynch's drawing tool holder. This would work just as one would expect it to – a user would select Lynch's drawing tool holder & be able to draw images using the tools taught by Microsoft Paint. This yields predictable results. Changes to the prior art utilizing known methods yielding predictable results are considered obvious.

**Claims 43 & 44-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lynch (US 5,896,133) in view of Moursund (US 5,644,739).**

**Claims 43, 48:** Lynch discloses the invention substantially as claimed as presented above with respect to claim 1 but does not disclose a toolbar with a modifiable portion on the touch screen display. In a related invention, Moursund teaches a toolbar with a modifiable portion. (See Moursund Abstract). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to provide a modifiable toolbar as taught by Moursund in Lynch's system for the purpose of user customization. (See Moursund Col. 2. Lines 9-15).

**Claim 44:** See Lynch Fig. 1, stylus 110, allowing the user to select any of the activities shown in Fig. 3. The stylus is an input device allowing the user to interact with the touch-screen display.

**Claims 45, 46:** See Col. 4. Lines 53-56 disclosing read only memory including removable magnetic discs. Inserting a disc is interpreted as inserting a cartridge having read only memory. Program or activity data is encoded onto the disc. The disc is inserted into a port configured to accept the disc. As set forth above, there are a plurality of interactive tools enabling the selection of activities. With the magnetic disc embodiment, these tools would be loaded from the disc.

**Claims 47:** See Fig. 3, toolbar 182, printed on the bottom of the screen.

**Claims 49, 50:** See Fig. 9A, erase button 439. The claims recite "configured to" & fail to positively recite the subsequent claim steps.

**Claim 51:** See Fig. 3, drawing toolbox 198.

### ***Conclusion***

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to OMKAR A. DEODHAR whose telephone number is (571)272-1647. The examiner can normally be reached on M-F: 8AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/OAD/

/Peter D. Vo/  
Supervisory Patent Examiner, Art Unit 3714